

Appin. No. 10/065,693
Docket No. 123921 / GEM-0061

REMARKS / ARGUMENTS

Applicant appreciates the Examiner's remarks regarding the withdrawal of the Restriction Requirement.

Status of Claims

Claims 1-20 are pending in the application. Claims 1-20 stand rejected. Applicant has canceled Claims 11-20, amended Claims 1 and 10, and added new Claims 21-24, leaving Claims 1-10 and 21-24 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Status of Drawings

The drawings filed on 11 November 2002 are accepted by the Examiner.

Objections to the Claims

Claim 1 is objected to because of an informality relating to the use of the word "monitoring" as opposed to the word "monitor".

Applicant has amended Claim 1 to correct for the typographical error as suggested by the Examiner.

Claims 13-16 are objected to because of an informality relating to antecedent basis.

Applicant has canceled Claims 13-16, thereby obviating this objection.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of these objections.

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Rejections Under 35 U.S.C. §102(b)

Claims 1-3 and 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Uemura et al. (U.S. Patent No. 4,262,674, hereinafter Uemura).

Claims 11-12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Affeldt et al. (U.S. Patent No. 4,112,929, hereinafter Affeldt).

Claims 17-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ueda (U.S. Patent No. 4,200,259, hereinafter Ueda).

Regarding Claims 1-3 and 10

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference*.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the *** claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

The Examiner alleges that Uemura discloses the claimed invention including a deflation (air bleed and quick release) valve 116 and 106 connected *intermediate* the monitor 105 and cuff 101, and a controller (driving circuits) 109 and 110 *for controlling the blood pressure monitor* [105], and that Uemura’s blood pressure monitoring system is automatic *because* the monitoring is done electronically using the driving circuits 109 and 110. Paper 11192004, Page 3. (Emphasis added).

In respectful disagreement with the Examiner, Applicant submits that Uemura does not specifically disclose the claimed invention of Claim 1 having, inter alia, “...a

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deflation valve connected *intermediate* said blood pressure monitor and said blood pressure cuff; and a controller for *automatically controlling the non-invasive blood pressure monitoring system*", having elements *arranged as claimed* in the instant invention.

Dependent claims inherit all of the limitations of the parent claim.

In the instant invention, Applicant's deflation valve 130 is connected *intermediate (lying between two extremes)* the blood pressure monitor 110 and the blood pressure cuff 120. Here, Applicant's deflation valve is *serially connected between* the blood pressure monitor and the blood pressure cuff such that the blood pressure cuff is in direct pneumatic communication with the blood pressure monitor *via the deflation valve*, as depicted in Figure 1 of the application as originally filed.

While Applicant admits that Uemura discloses a deflation (air bleed and quick release) valve 116 and 106 pneumatically connected to a pressure transducer 105 and cuff 101 (Figure 1), Applicant submits that since the Uemura deflation valve 116, 106 is disposed in a branch pneumatic line off of a direct pneumatic line from air pump 103 to pressure transducer 105 (See Figure 1 of Uemura), it necessarily follows that Uemura cannot disclose deflation valve 116, 106 connected *intermediate* the pressure transducer 105 and cuff 101 in such a manner that anticipates that claimed invention *arranged as claimed*.

Under the ordinary meaning of the term "intermediate", which Applicant submits means "lying between two extremes", it follows that a valve lying in a branch line between *the two extremes of a cuff and ambient* (see Figure 1 of Uemura) necessarily cannot also be a valve lying between *the two extremes of a cuff and a monitor* (the claimed invention). Accordingly, Uemura does not disclose the claimed invention *arranged as claimed* and therefore cannot be anticipatory.

Absent anticipatory disclosure in Uemura of each and every element of the claimed invention arranged as in the claim, Uemura simply cannot be anticipatory.

Furthermore, in the instant invention, Applicant claims, inter alia, "...a controller for *automatically controlling the non-invasive blood pressure monitoring system*."

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While the Examiner alleges that Uemura discloses the aforementioned claimed elements (paper 11192004, page 3), the Examiner does so by alleging that Uemura's blood pressure monitoring system is automatic *because* the monitoring is done electronically using the driving circuits 109 and 110. Furthermore, the Examiner alleges that the driving circuits 109 and 110 control the pressure transducer 105 (viewed by the Examiner as a monitor 105. Paper 11192004, Page 3).

In respectful disagreement with the Examiner, Applicant submits that a rejection under anticipation must be done by showing in a single prior art reference the disclosure of each and every element of the claimed invention *arranged as claimed*. Here, the Examiner alleges anticipation not by a showing, but by an explanation. Accordingly, Applicant submits that the Examiner has not properly met the burden of showing anticipation.

In Uemura, the driving circuits 109, 110 are disclosed as being a driving circuit 109 for a systolic blood pressure indicating tube (LED), and a driving circuit 110 for a diastolic blood pressure indicating tube (LED). Col. 5 lines 14-17. Applicant does not find where Uemura discloses driving circuits 109, 110 being driving circuits for automatically controlling the non-invasive blood pressure monitoring system as claimed, does not find driving circuits 109, 110 controlling pressure transducer (monitor) 105, and the Examiner has not shown with specificity where Uemura does disclose such an arrangement.

By alleging anticipation absent specific reference to anticipatory elements that may be found in Uemura, Applicant respectfully submits that the Examiner has failed to properly meet the burden of a showing of anticipation.

Regarding Claim 2 Specifically

The Examiner alleges that Uemura *teaches* manually operated deflation valves 116 and 106 (see col. 5, lines 2-4). Paper 11192004, page 3 (emphasis added).

At the outset, Applicant respectfully submits that a reference that *teaches* but not *discloses* cannot properly be used to reject the instant invention under anticipation.

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In respectful disagreement with the Examiner, Applicant submits that Uemura as referenced discloses an air bleed valve 106 and a quick release valve 116 for discharging air, and that the air bleed valve 106 is so designed as to discharge air while decreasing the inner pressure of the cuff 101 at the constant rate of approximately 3 mmHg/sec. Col. 5 lines 2-7. By the very language of Uemura, Applicant submits that not only does Uemura not specifically disclose valves 106 and 116 being manually operated, but also that Uemura implies from the language "so designed as to discharge air while decreasing the inner pressure of the cuff 101 at the constant rate of approximately 3 mmHg/sec" that the valves 106 and/or 116 may be controlled in a way other than manually.

Accordingly, Applicant submits that Uemura is absent specific disclosure of each and every element of the claimed invention arranged as claimed, and therefore cannot be anticipatory.

Regarding Claim 10 Specifically

Applicant has amended Claim 10 to now recite, inter alia, "...an automatic blood pressure monitor comprising said blood pressure monitor and said controller *integrally arranged as a single unit*." Support for this claim amendment may be found in the specification as originally filed at paragraph [0012] and in Figure 1. No new matter has been added.

The Examiner alleges that Uemura *teaches* an automatic blood pressure monitor (complete circuitry 105, 109 and 110) comprising the monitor 105 and the controller 109 and 110 (see fig. 1). Paper 11192004, page 3 (emphasis added).

At the outset, Applicant respectfully submits that a reference that *teaches* but not *discloses* cannot properly be used to reject the instant invention under anticipation.

In respectful disagreement with the Examiner, Applicant submits that Uemura as referenced discloses a pressure transducer 105, a driving circuit 109 for driving a systolic LED, and a driving circuit 110 for driving a diastolic LED, none of which appearing to be integrally arranged into a single unit. Figure 1 and Col. 5 lines 14-17. Applicant does not find Uemura to disclose the claimed invention that specifically claims "...an automatic blood pressure monitor comprising said blood pressure monitor and said controller

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integrally arranged as a single unit," and the Examiner has not shown with specificity where such disclosure may be found.

Accordingly, Applicant submits that Uemura is absent specific disclosure of each and every element of the claimed invention arranged as claimed, and therefore cannot be anticipatory.

In view of the foregoing, Applicant submits that Uemura does not disclose each and every element of the claimed invention arranged as in the claim, and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Regarding Claims 11 and 12

Applicant has canceled Claims 11 and 12 without prejudice, thereby obviating this rejection.

Regarding Claims 17-20

Applicant has canceled Claims 17-20 without prejudice, thereby obviating this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 4-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Uemura as applied to Claim 3 above, and further in view of Ueda. The Examiner acknowledges that Uemura does not teach the claimed subject matter and looks to Ueda, which allegedly teaches the subject matter of Claims 17-20, to cure this deficiency. Paper 11192004, page 5.

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Affeldt as applied to Claim 12 above, and further in view of Uemura. The Examiner acknowledges that Affeldt does not teach the step of actuating a manual deflation valve located intermediate the automatic blood pressure monitor and the blood pressure cuff, alleges that it is well known in the prior art to place a manual deflation valve intermediate

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the monitor and cuff, and alleges that Uemura for example teaches an air bleed valve 106 and/or quick release valve 116 for discharging air pneumatically intermediate of cuff 101 and monitor (pressure sensor) 105 (see fig. 1). Paper 11192004, page 6.

Claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Affeldt in view of Uemura as applied to Claim 13 above, and further in view of Ueda. The Examiner acknowledges that Affeldt and Uemura do not teach the steps as claimed, and looks to Ueda to cure this deficiency. Paper 11192004, page 6.

Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Affeldt as applied to Claim 12 above, and further in view of Ueda. The Examiner acknowledges that Affeldt does not teach the claimed subject matter, and looks to Ueda to cure this deficiency. Paper 11192004, page 7.

Applicant traverses these rejections for the following reasons.

Regarding Claims 4-9

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Claims 4-9 depend either directly or indirectly from Claims 1-3.

In view of Applicant's remarks above regarding the rejection under 35 U.S.C. §102, where Applicant submits that Claims 1-3 are patentable over Uemura, Applicant further submits that Ueda does not cure the deficiencies of Uemura with regard to Claims 1-3.

In view of a dependent claim being dependent upon an allowable independent claim, Applicant submits that Claims 4-9 are now patentable over Uemura and Ueda.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and disclose a substantially

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different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Regarding Claim 13

Applicant has canceled Claim 13 and has presented new Claim 24 that is directed to an invention similar to that of original Claim 13 but in alternative language. Support for new Claim 24 may be found in the application as originally filed. No new matter has been added.

The Examiner rejected original Claim 13 alleging that it is well known in the prior art to place a manual deflation valve intermediate the monitor and cuff, and alleged that Uemura for example teaches an air bleed valve 106 and/or quick release valve 116 for discharging air pneumatically intermediate of cuff 101 and monitor (pressure sensor) 105 (see fig. 1). Paper 11192004, page 6.

At the outset, Applicant respectfully submits that a broad rejection alleging that it is well known in the prior art to arrive at the claimed invention without recital of the well know prior art providing such a teaching, constitutes improper grounds for an obviousness rejection.

By alleging that Uemura teaches an air bleed valve 106 and/or quick release valve 116 for discharging air pneumatically intermediate of cuff 101 and monitor (pressure sensor) 105 (see fig. 1), the Examiner has failed to show where the prior art specifically teaches or suggests all of the elements of the claimed invention, which now recites, inter alia, "...actuating a ***manual deflation valve to rapidly deflate*** the blood pressure cuff for removal of the blood pressure cuff from the patient after completion of the blood pressure monitoring, the manual deflation valve being ***serially connected between the blood pressure monitor and the blood pressure cuff such that the blood pressure cuff is in direct pneumatic communication with the blood pressure monitor via the serially connected manual deflation valve***, the rapid deflation of the blood pressure cuff being possible by ***single-handed operation*** of the manual deflation valve."

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Accordingly, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant submits that Claim 24 is directed to allowable subject matter and respectfully requests entry and notice of allowance thereof.

Regarding Claims 14-16

Applicant has canceled Claims 14-16 without prejudice, thereby obviating these rejections.

Regarding New Claims 21-23

Applicant has added new Claims 21-23, which are directed to inventions similar to those of Claims 1 and 10, but in alternative language.

In view of the previous discussion relating to Claims 1 and 10, Applicant respectfully submits that new Claims 21-23 are directed to allowable subject and respectfully requests entry and notice of allowance thereof.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and respectfully request that the Examiner reconsider and withdraw these rejections.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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